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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,590	04/21/2004	Yi-Qun Li	-017 ITMX-00017USO	6712
23910	7590	11/03/2008	EXAMINER	
FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			KOSLOW, CAROL M	
ART UNIT	PAPER NUMBER			
		1793		
MAIL DATE	DELIVERY MODE			
11/03/2008	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/829,590	Applicant(s) LI ET AL.
	Examiner C. Melissa Koslow	Art Unit 1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 September 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 4-9, 15 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 4-9 and 15 is/are allowed.
- 6) Claim(s) 19-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This action is in response to applicants' amendment of 2 September 2008. The amendments to the specification have overcome the objection to the specification for failing to provide proper antecedent basis for the claimed subject matter. The amendments to the claims have overcome the objection and rejections of claim 10. Applicant's arguments with respect to the remaining rejections and objections have been fully considered but they are not persuasive.

The disclosure is objected to because of the following informalities: In paragraph [0005] the conjunctions between the elements defining A, B and M are missing, i.e. the conjunctions between "Pb" and "Cd" is missing and the conjunction between "Co" and "Mn" is missing. In paragraph [0005], "4+" should be "4⁺". In paragraphs [0005] and [0016], the conjunction between "4⁺" and "3⁻" in the definition of B is missing. Appropriate correction is required.

The amendment did not overcome the objection. The Examiner has further explained the objection so as to make it clear what she meant. The objection is maintained.

The amendment filed 2 September 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In new paragraph [0005.1], the phrase "In another embodiment, "x ranges from 0 to 0.15" is new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Applicants argue that the added range is found in original claims 1-3. Original claim 1 teaches $0 < x < 0.15$ and original claim 3 teaches x is a range from 0 to 0.15. The Examiner rejected claim 3 as being broader in scope than claim 1 if the phrase means " $0 \leq x \leq 0.15$ " or as not further

limiting if the phrase means $0 < x < 0.15$. The response to this rejection was the cancellation of claim 3 with no explanation as to what was meant by the phrase. Thus while it is not clear from the originally filed disclosure if “x is a range from 0 to 0.15” means $0 < x < 0.15$ or $0 \leq x \leq 0.15$. It is clear that the rest of original disclosure teaches $0 < x < 0.15$ with no indication that x can be 0 or 0.15. Thus, the teachings in the rest of the disclosure does not indicate that the inventor(s), at the time the application was filed, had possession of $0 \leq x \leq 0.15$ and thus this range is considered new matter.

Claims 19-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed x range is not supported by the originally filed disclosure if it means $0 \leq x \leq 0.15$. The originally filed disclosure is $0 < x < 0.15$, but the newly claimed range is $0 \leq x \leq 0.15$. In addition, the specification teaches only those calcium and barium titanates, hafnates or zirconates containing 5 mol% Fe substituted for Ba or Ca will have the claimed properties. The originally filed disclosure does not teach all the compositions that fall within the formulas of claims 19-24 will have the claimed properties.

As discussed above, it is unclear if original claim 3 meant $0 < x < 0.15$ or $0 \leq x \leq 0.15$. Given the teaching in the rest of the originally filed disclosure that $0 < x < 0.15$, the claimed range of $0 \leq x \leq 0.15$ was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

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possession of it. The rejection over the value of x is maintained. Applicants did not address the second part of the rejection with respect to the properties. The rejection is maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/cmk/
November 1, 2008

/C. Melissa Koslow/
Primary Examiner
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